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IN THE

Supreme Court of the United States

October Term, 1967

No. .....

TOOL RESEARCH AND ENGINEERING CORPORATION,
Petitioner,

vs.

HONCOR CORPORATION,
Respondent.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit, Brief for Honcor Corporation, Respondent in Opposition.

Opinion Below.

The District Court Opinion is reported at 240 F. Supp. 296, 145 USPQ 249, and the Judgment, Findings of Fact, and Conclusions of Law therein are set forth as Appendix A of the Petition in this matter.

The Court of Appeals decision is reported at 367 F.2d 449, 151 USPQ 236, and is set forth as Appendix B to the Petition.

Jurisdiction.

The jurisdictional requisites are adequately set forth in the Petition.

Question Presented.

Respondent disagrees with Petitioner's representations as to the questions presented and respectfully submits the real question to be as follows:

> Should 35 U.S.C. 102(b) be interpreted as to require the granting of a patent upon an invention which was obvious in the light of a related invention placed in public use more than one year prior to the filing of the application for patent?

Constitutional Provision and Statutes Involved.

The Constitution of the United States, Article I, Section 8:

> "The Congress shall have Power . . .
> * * *
> "To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries;"

35 U.S.C. 102:

> "A person shall be entitled to a patent unless—
> * * *
> "(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States, . . ."

35 U.S.C. 103:

> "A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences

between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

Statement.

Petitioner, hereinafter called Tool Research, brought action in the District Court against respondent, hereinafter called Honcor, for infringement of United States Letters Patent 2,951,145, to Anspach and 2,975,263 to Green *et al.*

Anspach '145 was held by the District Court to be invalid and appellant abandoned the contest with respect thereto.

Green '263, filed in United States Patent Office on July 6, 1954, is directed to an alleged invention entitled "Method for Producing Honeycomb Structures". It was also held invalid by the District Court and that decision was affirmed by the Court of Appeals.

Tool Research's predecessor and assignor, the John F. Foster Company, made, gave away, and sold core made by "said method" disclosed in Green '263 using flat material more than one year prior to the Green '263 filing date.

The Green '263 patent teaches that "said method" is usable with flat material and with corrugated material (Green '263, Col. 3, lines 26-30).

The District Court held:

(a) "any difference between the use of 'said method' with flat material and with precorrugated material being such as to be obvious to one skilled in the art."

(F of F, IX; Pet. Appen. A, p. 4.)

(b) "The 'said method' using flat material and known as the 'flat pack method' (EAC) was in public use in 1952 and early 1953, more than one year prior to the filing of Green '263 on July 6, 1954."

(F of F, XI; Pet. Appen A, p. 5.)

(c) "The claims of the Green-Hagan '263 patent call for a method using precorrugated material which is 'unpatentable over' the same method using flat material which was in public use more than one year prior to the filing date of the Green '263 patent."

(C of L, 4; Pet. Appen. A, p. 12.)

The Court of Appeals agreed with the District Court and said:

(a) ". . . the invention should fall within 102(b) if the differences between the claimed thing and the sold or used thing are obvious to one skilled in the art. In either case unless the improvements would be patentable, the inventor has used or disclosed his invention contrary to the purpose of Section 102(b).

(Pet. Appen. B, p. 23.)

(b) "We agree with the District Court that the process was in public use. Whether one method or two be involved and whether we treat the question as one of fact or law, the differences between the flat pack method and the preformed method did not amount to an invention.

(Pet. Appen. B, p. 23.)

(c) "Once the flat-pack method is disclosed, we think that the appearance of the completed core in itself suggests to one skilled in the art the use of precorrugated foil. After such suggestion the shape of the fingers is dictated by the shape of the corrugation. The requirements for pressure on the welding wheel and an expansion step simply disappear."

(Pet. Appen. B. p. 23.)

As stated by the Court of Appeals petitioner at one time agreed that it was obvious to use the "flat pack" method with preformed core and its closing brief in an interference in the Patent Office contained the following:

"Therefore it is readily apparent that Green et al, (plaintiff's predecessor), the senior party, rely on the entire disclosure of the application including the specification and the drawings (the drawings except for Figure 6 related to the flat-pack method) to support their right to make the two counts of the interference (both referring to the preform method) and *it is readily apparent to one*

skilled in the art how the teachings of the method would be applied to the manufacture of pre-formed core utilizing sections of corrugated metal foil." (Emphasis added.)

(Pet. Appen. B, p. 24.)

It is seen that the District Court, the Court of Appeals, and the petitioner at an earlier time, agreed that the method using preformed material was obvious from the method using flat material. The latter was found to have been in public use more than one year prior to the filing of the application resulting in the Green patent in suit.

Petitioner contends that notwithstanding the foregoing it is entitled to a patent upon the obvious variant, really the "said method" according to the patent, and that the refusal of the Court of Appeals to recognize that fact involves important issues entitled to the consideration of this Court.

ARGUMENT.

I.

The Decisions of the Trial Court and of the Court of Appeals Are Clearly Correct.

35 U.S.C. Section 102(b) provides:

> "A person shall be entitled to a patent unless—
>
> * * * * *
>
> "(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States . . ."

It is petitioner's position that the public use of the method using flat material did not bar its right to a patent upon a method obvious in view thereof.

Stated differently, petitioner contends that 35 U.S.C. 102(b) has no application unless the method in public use was identical to the method claimed.

It is to be remembered that, as held by this Court in *Electric Storage Battery Co. v. Shimadzu,* 307 U.S. 5, 20, 83 L. Ed. 1071, 1081, 41 USPQ 155, 161 (1939):

> "The ordinary use of a machine or the practice of a process in a factory in the usual course of producing articles for commercial purposes is a public use."

In the *John Deere* Cases, *Graham v. John Deere, Calmar, Inc. v. Cook Chemical Co.* and *Colgate-Palm-*

olive Co. v. Cook Chemical Co., 383 U.S. 1, 148 USPQ 459 (Feb. 1966) this Court clearly stated:

> "At the outset it must be remembered that the federal patent power stems from a specific constitutional provision which authorizes the Congress 'To promote the Progress of . . . useful Arts . . .' This is the *standard* expressed in the Constitution and it may not be ignored. And it is in this light that patent 'validity requires reference to a standard written into the constitution.' "

The constitutional standard may be implemented by statutory direction and administered according to the statutory scheme but in a manner whereby to give effect to the constitutional standard. Petitioner seeks to have the statutory enactment interpreted in a manner which does not have that effect.

Petitioner, in effect, insists that the Constitutional standard be ignored, that a method obvious in the light of a method in public use be held patentable, and that a patent otherwise invalid for failing to measure up to that constitutional standard be held valid upon the grounds that it is patentable under the wording of 35 U.S.C. 102(b).

Petitioner's position is premised unrealistically upon semantics and not upon the fundamentals of the relevant law.

II.

The Present Case Does Not Present a Question of Public Importance in a Meaningful Context.

This Court has said:

> "While this Court decides questions of public importance it decides them in the context of meaningful litigation. . . ."
>
> *The Monrosa v. Carbon Black, Inc.*, 359 U.S. 180, 184.

It is difficult to recognize that the present litigation is meaningful in view of the following:

1. The Green '263 patent at column 3, lines 26-30 defines the method which petitioner seeks to patent as "said method" which the District Court found in public use more than one year prior to the Green application filing date;
2. The petitioner in the Patent Office admitted the method it now seeks to patent was obvious in the light of the method with other material (Pet. Appen. B, p. 24);
3. The District Court found the method petitioner here seeks to patent was obvious in view of the prior art (F of F, IX, Pet. Append. A, p. 4);
4. The Court of Appeals agreed with the District Court (Pet. Appen. B, p. 23);
5. If the method petitioner here seeks to patent was obvious in the light of the method in public use more than one year then it does not meet the Constitutional standard of invention; and
6. This Court has recently reaffirmed in the John Deere cases that an invention not meeting the Constitutional standard is not patentable.

III.

Relative to Petitioner's Reason I for Granting the Writ.

"The Ninth Circuit Court of Appeals Decided a Federal Question in a Way in Conflict With an Applicable Decision in This Court."

The "federal question" petitioner refers to is set forth *supra* under the title "QUESTIONS PRESENTED" on page .....

The statute was enacted in 1952. The "applicable decision" referred to by petitioner is *Smith & Griggs Mfg. Co. v. Sprague,* 123 U.S. 249 decided in 1887, some 60 years prior to the statute involved.

In construing Section 102 of 35 U.S.C. the Court of Appeals made a deduction from the early 1887 case of *Smith & Griggs v. Sprague* saying:

> "We deduce from this case that not every improvement is sufficient to take a prior invention out of the operation of Section 102(b)."
>
> (Pet. Appen. B, p. 23.)

Obviously, Smith & Griggs did not construe Section 102(b). Instead the Court of Appeals construed Section 102(b) using Smith & Griggs only as background.

Smith & Griggs did not pass upon the question of whether a variant "obvious" in view of an invention in public use could be patented by virtue of not being identical to that invention. Smith & Griggs clearly ruled that a non-experimental use in production for public sale was a public bar if continued for the statu-

tory period. During that period experiments were conducted and the machine changed. In the words of the judge of the circuit court, not this Court:

> "These changes, which are apparently not of great importance, perfected the invention, and enabled the inventor to take the final step between partial and complete success."

Whether in using the words "not of great importance" the circuit court judge meant they were "changes" in relatively unimportant parts of the machine, or whether he meant the extent of changes or modification in the prior structure were "relatively unimportant", is not clear. One thing is clear, however, and that is the question of whether the "changes" were or were not "obvious" was never considered, either by the circuit judge or by this Court. It follows that the Court of Appeals below in ruling:

> "In either case the invention should fall within 102(b) if the differences between the claimed thing and the sold or used thing are obvious to one skilled in the art."

was not deciding that question in conflict with any law laid down in Smith & Griggs.

In 1 Walker, Patents 355-56 (Deller's Edition 1937) it is stated:

> "Precise identity between the thing covered by the patent, and the thing which the inventor allowed to be in public use or on sale more than two years before he applied for that patent, is not necessary to constitute constructive abandonment

> of the invention covered by the latter. It is enough if the two devices are substantially the same (Hall v. Macneale, 107 U.S. 90 (1883); Theberath v. Trimming Co., 15 Fed. 246, 251 (1883)), or if the advance from one to the other did not amount to invention (International Tooth Crown Co. v. Gaylord, 140 U.S. 55, 62 (1891)), but it is not enough that the two devices perform the same function, and are somewhat similar in construction and in mode of operation. (Draper v. Wattles, 3 Bann. & Ard. 618, Fed.Cas. No. 4,073 (1878))."

In the decision of this Court in *Hall v. Macneale,* 107 U.S. 90, 2 S.Ct. 73, 27 L.Ed. 367, this Court said at page 97 in holding that a nonexact earlier use destroyed patentability:

> "The invention was complete in those safes. It was capable of producing the results sought to be accomplished though not as thoroughly as with the use of welded steel and iron plate."

The courts have long followed the rule that the earlier use need not be of the exact thing patented in order to prevent a variant being patentable. In *National Biscuit Co. v. Crown Baking Co.,* 105 F.2d 422, 42 USPQ 214 (1st Cir. 1939), the Court said:

> "Undoubtedly the machines on the alleged prior use must be capable of being operated commercially, but it is not necessary to prove that such earlier machines were as efficatious as the one for which the patent was granted. Smith & Griggs Mfg. Co. v. Sprague, supra. If they embodied substantially the principles and elements of the invention, they invalidated the patent."

Similar holdings may be found in *Atlas v. Eastern Airlines, Inc.*, 311 F.2d 156, 162; 136 USPQ 4, 8-9 (1st Cir. 1962), cert. denied, 373 U.S. 904, 83 S.Ct. 1290, 10 L.Ed. 2d 199, 137 USPQ 912 (1963); *Sperry Rand Corp. v. Bell Tel. Labs., Inc.*, 208 F.Supp. 598, 135 USPQ 254 (S.D. N.Y. 1962), appeal dismissed, 317 F.2d 491, 137 USPQ 497 (1963); *Morrill v. Automatic Indus., Inc.*, 93 F.Supp. 697, 87 USPQ 70 (W.D. Mo. 1950). Also see *Trimpak Corp. v. Schenectady Lumber Co.*, 29 F.Supp. 85, 89, 42 USPQ 363, 367 (N.D. N.Y. 1939) aff'd mem., 119 F.2d 424, 49 USPQ 756 (1941), where the court cited Walker on Patents with approval.

IV.

Relative to Petitioner's Reason II for Granting Writ.

"35 U.S.C. Section 103, Enacted in 1952 Overruled Smith & Griggs as Interpreted by the Ninth Circuit Court of Appeals."

Analyzing the above "Reason" for better understanding we need to focus upon (1) Smith & Griggs as interpreted by the Ninth Circuit Court of Appeals; and (2) 35 U.S.C. Section 103.

As to (1), the Court of Appeals below said relative to Smith & Griggs:

> "We deduce from this case that not every improvement is sufficient to take a prior invention out of the operation of Section 102(b)."

As to (2), Section 103 provides:

> "A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the dif-

> ferences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. . . ."

As viewed by the Court of Appeals "not every improvement" escaped the bar to a patent raised by Section 102(b).

As recited in Section 103 if the particular improvement or difference were "obvious" it is not patentable.

There is no inconsistency and clearly Section 103 is in complete agreement with the deduction of the Court of Appeals drawn from Smith & Griggs.

We find petitioner here in the interesting position of contending that the Court of Appeals incorrectly interpreted Smith & Griggs and then supplementing that contention by the further contention that 35 U.S.C. 103 overruled that incorrect interpretation.

As stated by this Court in the *John Deere* cases, 35 U.S.C. Section 103 did not change the standard for patentability. This Court there said:

> "Although we conclude here that the inquiry which the Patent Office and the courts must make as to patentability must be beamed with greater intensity on the requirements of §103, it bears repeating that we find no change in the general strictness with which the overall test is to be applied. We have been urged to find in §103 a relaxed standard, supposedly a congressional reaction to the 'increased standard' applied by this Court in its decisions over the last 20 or 30 years. The standard has remained invariable in this Court. . . ."

Graham v. John Deere, 383 U.S. 1, 19 (1966).

Petitioner cites numerous lower court decisions to support its contention that Section 102(b) does not bar a patent unless the prior public use is of the identical invention claimed in the application for patent which is being denied. To the extent that any of those decisions support the view that 35 U.S.C. 102(b) must be so interpreted as to require the granting of a patent upon subject matter obvious in the light of prior art they cannot stand.

Petitioner cites nine cases, three of which are by Courts of Appeal and six of which are by District Courts. Of the cases cited, two District Court cases support petitioner's position. They are:

Chicopee Mfg. Corp. v. Columbus Fiber Mills Co., Inc. (D.C. M.D. Georgia, 1958), 165 F. Supp. 307, 118 USPQ 53, 65;

Kaiser v. McLouth Steel Corporation (DC ED, Mich., 1966), 257 F.Supp. 372, 150 USPQ 239.

Of the remaining cases, none seriously or carefully considered the present issue.

In *Adams et al. v. Columbus Mfg. Co., Inc.* (M.D. Georgia 1960), 180 F.Supp. 921, 124 USPQ 92, so far as Section 102(b) was concerned, turned on the fact that the alleged public use was in fact experimental and so was not a bar.

In *Felburn v. The New York Central Railroad Company* (6 Cir., 1965), 350 F.2d 416 USPQ 622, the claims of the patent were held invalid under Section 103 although novel under the test of Section 102(b) because not identically disclosed in the prior art, the

court being of the view that such novelty alone would not support validity.

In *Wolowitz v. Gulf Oil Corporation* (DC, 1966), 255 F.Supp. 100, 149 USPQ 737, 739, the court said, in passing, that if a single reference did not disclose the invention claimed in all material respects then Section 103 and not Section 102 is applied.

In *Technicon Instruments Corp. v. Coleman Instruments Inc.* (ND Ill., 1966), 255 F.Supp. 630, 150 USPQ 227, 233, the question of identity of prior art to the claimed invention as to justify the application of Section 102(b) was not considered.

In *George R. Churchill v. American Buff* (7 Cir., 1966), 365 F.2d 129, 150 USPQ 417, the court found that the product sold was the product claimed and the question of obviousness did not arise.

In *J. L. Clark Mfg. Co. v. American Can Co.* (DC NJ, 1966), 256 F.Supp. 719, 151 USPQ 313, what the court said about Section 102(b) was *obiter dictum:*

> ". . . While a determination of this issue is not essential, in view of our holding of invalidity for lack of invention . . ."

In *Ling-Temco-Vought, Inc. v. Kollsman Instrument Corp.* (2 Cir. 1967), ...F.2d ....., 152 USPQ 446, the remarks of the court relative to Section 102(b) were incidental for the prior art was admittedly in existence at the time the invention of the patent in suit was made and the case was decided under Section 103.

These cases give very slight support to petitioner's position.

V.

Relative to Petitioner's Reason III for Granting the Writ.

"The Ninth Circuit Court of Appeals Has Decided an Important Question of Federal Law Which Has Not Been, but Should Be, Settled by This Court, Namely, Whether the Conditions of Patentability in 35 U.S.C. Section 103 May Be Applied Not as of the Date the Invention Was Made, but More Than One Year Prior to the Patent Application, to Invalidate the Invention Under 35 U.S.C. Section 102(b)."

As petitioner states, the Court of Appeals did say that:

> ". . . the invention should fall within 102(b) if the differences between the claimed thing and the sold or used thing are obvious to one skilled in the art."

Section 102(b) provides that a patent cannot be obtained if

> "the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application . . ."

Petitioner contends that the "invention" referred to must be the *identical* invention in order that Section 102(b) apply and that obvious variants are not included.

Section 103 refers to obvious variants but relates to obviousness as of the "time the invention was made" and not to obviousness "more than one year prior to the date of the application."

No Court has faced this situation more squarely than the Court of Customs and Patent Appeals in a series of cases now to be discussed.

In a first decision, *In re Palmquist*, 51 CCPA 839, 319 F.2d 547, 138 USPQ 234, decided in 1963, the Court of Customs and Patent Appeals held that for Section 102(b) to be applicable the alleged public use more than one year prior to filing must fully disclose in every detail the claimed invention. This eliminated the use of obvious variations and modifications to anticipate.

The effect of the *In re Palmquist* decision was a breach in the long established law that one cannot obtain a patent upon that which has been in public use for more than one year prior to filing, or upon an obvious variation thereof.

The Court of Customs and Patent Appeals in two later decisions reversed *In re Palmquist* and returned the law for the Patent Office to the place it had been. They were as follows:

In re Foster (CCPA, April 15, 1965), 343 F.2d 980, 145 USPQ 166;

In re Folkers (CCPA, May 13, 1965), 344 F.2d 967, 145 USPQ 426.

In *In re Foster* the Court said:

"'Manifestly, Section 102(b) from its earliest beginnings has been and was intended to be directed toward the encouragement of *diligence* in the filing of patent applications and the protection of the public from monopolies on subject matter which had already been fully disclosed to it.'

"These statements are in accord with our understanding of the history and purposes of section 102(b). It presents a sort of statute of limitations, formerly two years, now one year, within which an inventor, even though he has made a patentable invention, must act on penalty of loss of his right to patent. What starts the period running is clearly the availability of the invention *to the public* through the categories of disclosure enumerated in 102(b), which include 'a printed publication' anywhere describing the invention. There appears to be no dispute about the operation of this statute in 'complete anticipation' situations but *the contention seems to be that 102(b) has no applicability where the invention is not completely disclosed in a single patent or publication,* that is to say where the rejection involves the addition to the disclosure of the reference of the ordinary skill of the art or the disclosure of another reference which indicates what those of ordinary skill in the art are presumed to know, *and to have known for more than a year before the application was filed.* Upon a complete reexamination of this matter, we are convinced that the contention is contrary to the policy consideration which motivated the enactment by Congress of a statutory bar. On logic and principle we think this contention is unsound, and we also believe it is contrary to the patent law as it has actually existed since at least 1898.

* * * * *

". . . If the reference contains enough disclosure to make his invention obvious, the principle of

the statute would seem to require denial of a patent to him. The same is true where a combination of two publications or patents makes the invention obvious and they both have dates more than a year before the filing date." (343 F. 2d 980, 987-8, 145 USPQ 166, 173).

* * * * *

". . . But on further reflection, we now feel bound to point out that of equal importance is the question of *loss of right* predicated on a one-year *time-bar* which, it seems clear to us, has never been limited to 'anticipation' situations, involving only a single reference, but has included as well 'no invention' (now 'obviousness') situations. It follows that where the time-bar is involved, *the actual date of invention becomes irrelevant* and that it is not in accordance with either the letter or the principle of the law, or its past interpretation over a very long period, to permit an applicant to dispose of a reference having a date more than one year prior to his filing date by proving his actual date of invention.

"Such a result was permitted by our decision in Palmquist and to the extent that it permitted a reference, having a publication date more than one year prior to the United States filing date to which the applicant was entitled, to be disposed of by proof of a date of invention earlier than the date of the reference, that decision is hereby overruled." (343 F. 2d 980, 989, 145 USPQ 166, 174).

In *In re Folkers* the Court said:

"Whatever right to a patent appellant may have had at the time the invention was made, it has

> been lost within the meaning of section 102(b), *if*, indeed, the claimed invention *became* obvious to one of ordinary skill in this art through the publication of the reference more than one year before appellant filed his application." (344 F.2d 967-8, 145 USPQ 426, 427).

The soundness of the law as recognized by the Court of Customs and Patent Appeals is clear and is consistent with the Constitutional purpose.

Petitioner contends it is entitled to a patent upon an obvious variant of a process in public use for more than one year, the statutory period, if it can establish that it made the obvious variant prior to the running of the one year bar.

Petitioner would eat its cake and still have it. Let us assume Petitioner invents two modifications, not patentably distinct, one being an obvious variant of the other, and uses one publicly for years. It then applies for a patent upon the second variant and successfully overcomes the bar of public use provided by Section 102(b) by showing that at the time the invention comprising the second variant was made there was no public use making it obvious. Petitioner would then receive a patent upon its second modification which does not meet the Constitutional standard for it does not "promote the progress of the useful arts" being an obvious variant of something already in the public domain.

Notwithstanding this clear frustration of the Constitutional purpose by giving to Section 102(b) the interpretation for which it contends, petitioner insists the words of the section so require.

Conclusions.

The statutes must be interpreted as to give effect to the Constitutional intent to promote the useful arts in the granting of a patent.

An interpretation of 35 U.S.C. 102(b) which requires that a patent be issued upon an invention which has been obvious for more than a year in the light of prior public knowledge or use does not carry out the Constitutional intent.

The position of petitioner is based upon semantics, not upon the basic law, and is without merit.

Respectfully submitted,

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